

Response to Office Action
Mailed March 17, 2003
For Serial No. 09/873,778

REMARKS

In the Official Action, the Examiner rejected claims 1-6, 15, 21-28, 37, 43, and 45 and withdrew claims 7-14, 16-20, 29-36, 38-42, and 44 from further consideration. As discussed below, the Examiner failed to present a *prima facie* case of obviousness. Accordingly, Applicants respectfully request reconsideration and allowance of the pending claims in view of the following remarks.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3, 15, 21-25, 37, 43, and 45 under 35 U.S.C. § 103(a) as obvious over Leung (U.S. Des. 350,126) in view of Schwartz et al. (U.S. Patent No. 5,841,076). The Examiner also rejected claims 4 and 26 under 35 U.S.C. § 103(a) as obvious over Leung et al. in view of Schwartz et al. and further in view of Moreno (U.S. Patent No. 6,351,225). Finally, the Examiner rejected claims 5, 6, 27, and 28 under 35 U.S.C. § 103(a) as obvious over Leung in view of Schwartz et al. and further in view of Terasawa et al. (U.S. Patent No. 6,016,139).

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). If the Examiner combines the teachings of the prior art to produce the claimed invention, a *prima facie* case of obviousness cannot be established absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d

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1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). As set forth in detail below, the Examiner did not meet his burden of establishing a *prima facie* case of obviousness.

***Independent Claims 1 and 23 and
Dependent Claims 2, 3, 15, 21, 22, 24, 25, 37, 43, and 45***

Independent claims 1 and 23 both recite, *inter alia*, a standard keypad, a track ball mechanism, and "a scroll mechanism being located less than one inch from the track ball mechanism." In the Office Action, the Examiner acknowledged: "Leung fails to teach clearly the actuation mechanism which is a scroll mechanism." Paper 7, Page 2. In view of the deficiencies of Leung, the Examiner turned to Schwartz et al. for a teaching of a keyboard 17 having a scroll mechanism. *See id.*

The Applicants respectfully traverse these rejections for the following reasons. First, as discussed in detail below, the Examiner has not provided a valid suggestion or motivation to combine the references. Second, the Leung and Schwartz et al. references teach away from one another.

First, the Applicants emphasize the lack of any motivation or suggestion to combine the references. In the Office Action, the Examiner stated:

Therefore, in view of the teachings of Schwartz et al., it would have been obvious to one of ordinary skill in the art to modify the keyboard of Leung by replacing the scroll mechanism as taught by Schwartz et al. for optimum operating of a keyboard in place of the actuation mechanism of Leung.

Paper 7, page 3. Even if such a combination were possible, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Leung and Schwartz et al. references based on the *conclusory and subjective statement* that the scroll keys 863 and 864 of Schwartz et al. would provide optimum operating of the keyboard of Leung, yet the Examiner provided no reasoning as to why such a combination would or could be made. Applicants emphasize that

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optimum is a highly subjective and relative term, which becomes vague without a point of reference. The Examiner neither defines "optimum operating" nor provides objective support for the alleged reason to combine the cited references. Even if "optimum operating" were defined, the Applicants stress the lack of any suggestion to combine the references to attain the unique features recited in the instant claims, e.g., "a scroll mechanism being located less than one inch from the track ball mechanism." Neither Leung nor Schwartz et al. suggests positioning a scroll mechanism and a track ball mechanism in close proximity, as claimed and described throughout the instant application. See Application, Page 2, lines 4-19, Page 5, lines 1-3, Page 9, lines 7-23. Accordingly, the Examiner has done nothing more than take "Official Notice" of a fact not in evidence and, therefore, Applicants challenge the Examiner to produce objective evidence supporting the Examiner's alleged reason to combine the cited references.

Even if objective evidence is identified to support the Examiner's alleged reason to combine the references, the Applicants submit that one of ordinary skill in the art would not be motivated to combine the Leung and Schwartz et al. references. There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d 1415, 1420-21 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999). The Examiner clearly *speculated* about the possibility of combining the reference without providing any objective evidence. Again, the Applicant

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challenges the Examiner to provide *objective evidence* of the requisite suggestion or motivation to combine or modify the references, rather than a mere statement of "optimum operating."

Second, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); see M.P.E.P. § 2143.01.

As discussed above, Leung illustrates a keyboard having a built-in trackball with some sort of feature below the trackball. The Examiner believes this feature to be an actuation mechanism, yet the Examiner has not provided any definition of such an actuation mechanism. Given the lack of any textual description, the Examiner is clearly relying on the drawings in the design patent of Leung. In view of the mere graphical nature of Leung, the drawings of Leung must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (C.C.P.A. 1979); see M.P.E.P. § 2125. Accordingly, the Applicants stress that one of ordinary skill in the art would most likely and most reasonably interpret the features below the trackball of Leung to be the standard *select* and *properties* buttons, which are common to mice, trackballs, and other pointing devices. Any other interpretation would be unreasonable. In view of the foregoing, the Examiner's proposed combination of the cited references would change the principle of operation of Leung, such that the trackball would be inoperable for its intended purpose. Without such *select* and *properties* buttons, a user would be unable to use the trackball effectively. For example, the user could move a cursor from point to point with the trackball, yet the user could not select items, pull up menus, or perform other functions without such *select* and *properties* buttons. To illustrate the unreasonableness of the Examiner's combination further, if the *select* and *properties* buttons were replaced with scroll buttons as proposed by the Examiner, then the user would simply have two different mechanisms for moving a cursor without any means for selecting items, clicking

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buttons, interacting with menus, and so forth. Accordingly, the proposed combination cannot be made.

In view of the foregoing remarks, the Examiner failed to present a *prima facie* case of obviousness. Accordingly, the Applicants respectfully request the Examiner withdraw the proposed combination of Leung and Schwartz et al. and withdraw the rejection of claims 1-3, 15, 21-25, 37, 43, and 45 under 35 U.S.C. § 103.

Dependent Claims 4 and 26

Claims 4 and 26 depend from independent claims 1 and 23, respectively, which are believed to be patentable over the Leung and Schwartz et al. references for the reasons discussed in detail above. The Moreno reference also fails to obviate the deficiencies of the Leung and Schwartz et al. references. In addition, the Applicants challenge the Examiner to provide *objective evidence* of the requisite motivation or suggestion to combine the cited references. Accordingly, claims 4 and 26 are believed to be patentable by way of their dependencies on independent claims 1 and 23, respectively.

Dependent Claims 5, 6, 27, and 28

Claims 5-6 and 27-28 depend from independent claims 1 and 23, respectively, which are believed to be patentable over the Leung and Schwartz et al. references for the reasons discussed in detail above. The Terasawa et al. reference also fails to obviate the deficiencies of the Leung and Schwartz et al. references. In addition, the Applicants challenge the Examiner to provide *objective evidence* of the requisite motivation or suggestion to combine the cited references. Accordingly, claims 5-6 and 27-28 are believed to be patentable by way of their dependencies on independent claims 1 and 23, respectively.

In view of the foregoing remarks, the Applicants respectfully request the Examiner withdraw all rejections under 35 U.S.C. § 103.

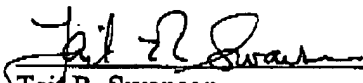
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Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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